



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Brinks Hofer Gilson & Lione
PO Box 10395
Chicago, Illinois 60610

COPY MAILED

SEP 11 2006

OFFICE OF PETITIONS

In re Application of
Tanabayashi et al.
Application No.09/786818
Patent No. 7010306
Attorney Docket No.9682/82

:
:
:
:DECISION DISMISSING PTA
:RECONSIDERATION
:
:

This decision is in response to patentees' REQUEST FOR REVIEW OF PATENT TERM ADJUSTMENT PURSUANT to 37 CFR 1.705(d) TIMELY FILED ON MAY 5TH requesting that the Office adjust the PTA at the time of the issuance of the patent from a determination of 535 to a determination of 1087 days.

Patentees' letter regarding PTA is **DISMISSED**. The proper amount of PTA at the time of the issuance of the patent is 535 days as printed on the front page of the patent.

Patentees are given 30-days or one month whichever is longer to respond to this decision. No extensions of time are granted under 37 CFR 1.136.

Patentees' assert that the Office made two errors in the determination of the PTA. 1) The Office failed to provide any additional PTA for the Office's failure to issue the application within three years of the filing date. 2) The Office assessed too much PTA reduction under 37 CFR 1.704(c)(10). Patentees' assert that the Office should assess any additional PTA addition of 563 days¹ which is the amount of time from the three year anniversary date until the date of filing the RCE. Patentees further assert that the only delay under 37 CFR 1.704(c)(10) is the submission of the drawings.

Patentees' assertions are not persuasive. Patentees argument relating to 37 CFR 1.702(b) is not persuasive. Patentees are advised that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more

¹Patentees assert that the additional 563 days began on March 10, 2004 (day after 3-year anniversary date and ended on September 23, 2005, date of submission of RCE request.

than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004). Because the PTA amount awarded under 37 CFR 1.704(a)(1) is greater than the delay under 37 CFR 1.702(b), applicants will receive no additional PTA time.

In addition, Patentees properly received a reduction of 46 and 25 days under 37 CFR 1.704(c)(10). Applicant submitted both an amendment under 37 CFR 312 as well as drawing submission on 12-27-05. The Office responded to the 312 amendment on January 20, 2006. The response did not address the submission of the drawings filed after the mail date of the notice of allowance. Accordingly, the reduction for the submission of the 312 amendment amounted to 25 days. The reduction for the drawings began on January 21, 2006² and amounted to 46 days.

After the mailing of this decision, the patented file will be forwarded to the file repository for proper storage of such patented file.

The Office has assessed the \$200.00 fee to deposit account 23-1925. No additional fees are required in deciding this request for reconsideration of the patent term adjustment determination.

Any questions concerning this decision should be directed to Kery A. Fries, Senior Legal Advisor, at 571-272-7757.



Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

cc: PTA determination

²It is noted that the drawing submission overlapped with the 312 amendment (both filed on 12/27/05) and the Office does not reduce the PTA for overlapping reduction periods. Accordingly, the drawing submission reduction began on January 21, 2006 and ended on March 7, 2006, the date for issuance of the patent.

Day : Thursday

Date: 9/7/2006

Time: 13:48:22

PALM INTRANET**PTA Calculations for Application: 09/786818**

Application Filing Date:	03/09/2001	PTO Delay (PTO):	663
Issue Date of Patent:	03/07/2006	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	128
Post-Issue Petitions:	0	Total PTA (days):	535
PTO Delay Adjustment:	0		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
75.5	02/15/2006	PTA 36 MONTHS			
75	03/07/2006	PATENT ISSUE DATE USED IN PTA CALCULATION			
74	01/31/2006	EXPORT TO FINAL DATA CAPTURE			
73	01/27/2006	FINISHED INITIAL DATA CAPTURE			
72	01/30/2006	DISPATCH TO FDC			
71	01/20/2006	MAIL RESPONSE TO 312 AMENDMENT (PTO-271)			
70	01/19/2006	RESPONSE TO AMENDMENT UNDER RULE 312			
69	12/27/2005	AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312)		25	71
68	01/11/2006	APPLICATION IS CONSIDERED READY FOR ISSUE			
67	12/27/2005	WORKFLOW - DRAWINGS FINISHED		46	
66	12/27/2005	ISSUE FEE PAYMENT VERIFIED			
65	12/27/2005	ISSUE FEE PAYMENT RECEIVED			
64	11/01/2005	EXPORT TO INITIAL DATA CAPTURE			
63	10/27/2005	MAIL NOTICE OF ALLOWANCE			
62	10/26/2005	ISSUE REVISION COMPLETED			
61	10/26/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
60	10/26/2005	NOTICE OF ALLOWABILITY			
59	09/23/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
58	09/23/2005	REFERENCE CAPTURE ON IDS			
57	09/23/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	53
56	10/06/2005	DATE FORWARDED TO EXAMINER			

55	09/23/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
54	10/06/2005	DATE FORWARDED TO EXAMINER			
53	09/23/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)		57	40
52	10/06/2005	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
51	09/23/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
45	09/23/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
44	07/18/2005	MAIL ADVISORY ACTION (PTOL - 303)			
43	07/14/2005	ADVISORY ACTION (PTOL-303)			
42	07/06/2005	DATE FORWARDED TO EXAMINER			
41	06/28/2005	AMENDMENT AFTER FINAL REJECTION			
40	04/28/2005	MAIL FINAL REJECTION (PTOL - 326)			
39	04/27/2005	FINAL REJECTION			
38	04/19/2005	DATE FORWARDED TO EXAMINER			
37	03/22/2005	RESPONSE AFTER NON-FINAL ACTION			
36	01/04/2005	MAIL NON-FINAL REJECTION			
35	01/03/2005	NON-FINAL REJECTION			
34	01/03/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
33	12/19/2004	DATE FORWARDED TO EXAMINER			
32	09/13/2004	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
31	12/19/2004	DATE FORWARDED TO EXAMINER			
30	09/13/2004	REQUEST FOR CONTINUED EXAMINATION (RCE)			
29	12/19/2004	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
28	09/13/2004	WORKFLOW INCOMING AMENDMENT IFW			
27	09/13/2004	WORKFLOW - REQUEST FOR RCE - BEGIN			
26	06/16/2004	MAIL FINAL REJECTION (PTOL - 326)			
25	06/14/2004	FINAL REJECTION			
24	06/09/2004	DATE FORWARDED TO EXAMINER			
23	06/01/2004	RESPONSE AFTER NON-FINAL ACTION			
22	06/01/2004	WORKFLOW INCOMING AMENDMENT IFW			
21	03/02/2004	MAIL NON-FINAL REJECTION	663		3
20	02/23/2004	NON-FINAL REJECTION			

19	01/02/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	09/09/2003	CASE DOCKETED TO EXAMINER IN GAU			
17	09/03/2003	CASE DOCKETED TO EXAMINER IN GAU			
16	07/16/2003	CASE DOCKETED TO EXAMINER IN GAU			
15	02/20/2003	CASE DOCKETED TO EXAMINER IN GAU			
14	01/14/2003	CASE DOCKETED TO EXAMINER IN GAU			
13	05/03/2001	PRELIMINARY AMENDMENT			
12	05/03/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	06/20/2001	CASE DOCKETED TO EXAMINER IN GAU			
10	05/18/2001	APPLICATION DISPATCHED FROM OIPE			
9	05/11/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
8	04/30/2001	CORRESPONDENCE ADDRESS CHANGE			
7	04/27/2001	RELEASED TO OIPE			
6	04/27/2001	NOTICE OF DO/EO ACCEPTANCE MAILED			
5	04/26/2001	371 APPLICATION PREEXAMINATION DOCKETING			
4	03/29/2001	371 APPLICATION PREEXAMINATION DOCKETING			
3	03/09/2001	RECEIPT OF 371 REQUEST			
2	03/29/2001	CORRESPONDENCE ADDRESS CHANGE			
1	03/09/2001	INITIAL EXAM TEAM NN			

Search Another: Application#

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back use Back button on your browser toolbar.

Back to [PALM](#) | [ASSIGNMENT](#) | [OASIS](#) | [Home page](#)